

U.S. Patent Application No. 10/052,900
Attorney Docket No. 1011/1

REMARKS

This amendment responds to the Office Action mailed November 29, 2007. Claim 7 has been amended to correct a typographical error. Claims 1-11 remain pending.

Claims 1, 2, 4 and 6-11 Are Patentable Over Gardner

The Examiner rejected claims 1, 2, 4 and 6-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,758,327 to Gardner [hereinafter "Gardner"]. The Examiner contends that Gardner discloses all of the elements recited in the claims at issue. The Applicant respectfully disagrees with the Examiner's characterization of this reference vis-à-vis the claims at issue.

In support of this rejection, the Examiner cites the following passages from Gardner:

In a first step 36 of FIG. 2, the requisition rules of each company 12, 14 and 16 are stored at the central computer system 10. There are a number of different components of the requisition rules. For example, the requisition rules of company 12 may include an authorization matrix that dictates persons who must approve a requisition, a routing engine that dictates the person-to-person sequence within the authorization process, and requirements related to bids. Other aspects of the requisition rules will be described below.

Column 5, lines 13-22

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A second step 38 is to store a catalog. The order of steps 36 and 38 may be reversed or carried out simultaneously. The catalog is stored as an electronic catalog and includes all information regarding approved products and services that are available to the companies 12, 14 and 16. These items may be pre-negotiated with the vendors 24, 26 and 28, so that cost savings are reflected in the stored prices. The electronic catalog is dynamic and facilitates the purchase of products and services in an automated fashion. That is, because the catalog items are pre-approved and pre-negotiated, once an item is requested and internally approved by the appropriate managers within the company organization, the item or items can be directly communicated to the appropriate vendor to fill the order, without the need for involvement in the transaction by a buyer that is associated with the procurement system and the central computer system 10. The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on previously negotiated contracts and eliminating non-value-added activities.

Column 5, lines 23-43

In the preferred embodiment, the step 38 of storing a catalog includes forming a single catalog that includes products and services of all of the vendors 24, 26 and 28. Thus, a single view of available information is presented to the requesters 18, 20 and 22. This is in contrast to a public database of catalog information in which information is segregated according to vendors. As a result, there are advantages to the requesters in terms of viewing the information. From the viewpoint of a vendor, products and services may be available to a larger audience of potential customers. If the volume of transactions with a particular vendor is sufficient, the operators of the central computer system 10 will have increased negotiating leverage in securing a favorable price for future transactions.

Column 5, lines 44-57

The requestor-to-system interface preferably allows any requestor to initiate an ordering process from a desktop computer, regardless of the computer platform used by the requestor. That is, the interface is transparent to operating systems and to company computer networks. One possibility is for access to the central computer system 10 to be by means of a worldwide web (WWW) homepage. One important benefit to such an ordering process is that it allows a requestor to track progress of requisitions all the way to the point of delivery. Computer system 10, however, allows tracking through to the point of payment. The process to be described below provides up-to-the-minute information as to the status of a request.

Column 6, lines 14-25

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As previously noted, the requester has the ability to track the progress of the requisition. The requester tracking engine may be automatic, so that the requester receives a copy of the requisition folder as each step is completed. Alternatively, the tracking engine may be one that requires the requester to initiate a status inquiry.

Column 8, lines 52-57

The application set forth in the present invention comprises a completely secure, web-based system that requires no dedicated phone or modem connections by the customers or vendors to access the system. Purchase Orders can be created by buyers of companies from anywhere around the world by using a web browser. Each company in the system is logically separated to provide privacy and security. The system also allows controlling the part level availability across countries/regions of the company's catalog. A single buyer from a company can create a purchase order for multiple locations across different countries in different currencies, which are then routed to the appropriate vendors by the order manager (which is an order routing rules engine). Vendors are also electronically integrated with the system, which allows the purchase orders to be routed to the vendors electronically and status updates from the different vendors to be electronically updated for the benefit of the buyer without manual intervention. The order manager allows configurations such as different vendors based on OEM of the parts, different margins per country/vendor and different vendor per country/location. The application also provides the landed cost of the product by maintaining up to date information of local trade block uplifts, duties and customs of various vendors in different countries. Once the purchase is completed by the buyers in the system, the application provided the ability to track and manage the purchased items throughout the lifecycle. Tracking and management includes things like warranty and service records. Thus, in short the present invention provides complete automation of purchasing through a large organization while provided complete customization of

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the process for each purchasing entity. These features are included in some of the claim elements that will be discussed below.

Referring specifically to independent claim 1, this claim includes the recitation “constructing an electronic catalog having one or more pages by selecting elements to be included in the pages, and providing commercial terms applicable to the included elements, *where the selecting and providing steps are performed consistent with contract terms between the purchasing entity and the vendor.*” This claim element is not disclosed by Gardner. Rather, the central computer system 10 of FIG 1 of Gardner is the entity that negotiates prices on behalf of the companies 12, 14, 16. *See* col. 5, lines 54-57. Such capability recited in claim 1 enables the system of the present invention to tailor products and deliveries to the user all under control of the purchasing entity (i.e., the company) – rather than requiring the company to adapt to the practices set forth by the central computer operator of Gardner. Moreover, country specific tariffs and delivery mechanisms based on the user can be provided in the system described in claim 1 but not Gardner.

Claims 2 and 4 includes similar recitations to that of claim 1 discussed above.

Claim 4 includes the additional recitation of “generating a plurality of web pages *to form a user-specific catalog* which includes a set of deliverables that may be supplied by a supplier to a purchasing entity, *wherein items contained in the set of deliverables and commercial terms for the supply of the deliverables are determined between the supplier and the purchasing entity in advance of the e-procurement session.*” This user-specific catalog formed for each user is based on the deliverable and commercial terms between the purchasing entity and the supplier – not the central computer and the vendor as disclosed by Gardner. This recited capability enables

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complete tailorization of many commercial aspects of a transaction, such as warranties and repair, as well as price, delivery options, taxes, local tariffs, etc. while doing so in an automated manner. Such capability is not provided for by Gardner. Thus, the present invention provides both the advantages of automation and customization, whereas Gardner provides no customization on the order fulfillment side.

Claim 6 includes a similar recitation – “generating one or more web-page listing items and prices associated with the listed items supplyable by an OEM to a purchasing entity, *where the listed items and prices are determined between the OEM and the purchasing entity in advance of the e-procurement session.*” Again, the price negotiation takes place between the purchasing entity and the OEM, for example, and not the central computer operator.

Claim 7 includes capability not disclosed by Gardner. First, claim 7 states “constructing a set of purchasable items *incorporating a pre-established standard of the organization.*” This pre-established standard is used to determine the items to be displayed to the user (“determining a subset of items for display to the user, and associated data for each of the displayed items, *consistent with the pre-established standard*”). Next, an order created by the user is forwarded to a vendor that has previously agreed to furnish the item in the order in accordance with the pre-established standard (“forwarding an order for selected ones of the displayed items selected by the user to a vendor *where the vendor and host agreed in advance of the forwarding that the order will be fulfilled in accordance with the pre-established standard*”). This capability is not possible with the system of Gardner, as Gardner teaches centralization (and therefore commoditization) of the purchasing in accordance with a relationship established by the central computer operators – not the companies. Therefore, the purchasing entities do not have the

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ability to tailor any aspects of the transaction to themselves (other than the internal routing process discussed in Gardner).

Claims 8-11 include recitations similar to that of claim 7 discussed above.

In summary, Gardner fails to teach the establishment of commercial terms between the company and the vendors, which terms are then used to control the display of catalog items to a user and purchasing of an item from the catalog when a user of the company purchases items through the system. In fact, Gardner teaches away from this capability because Gardner teaches that it is advantageous for companies to permit the central computer operator to negotiate on behalf of the companies to obtain better price terms. Col. 5, lines 54-57. As such, Gardner fails to include all of the limitations of the claims at issue; hence Gardner fails to anticipate the claims at issue. Moreover, Gardner fails to render obvious the same claims by teaching away from them. Therefore, reconsideration and withdrawal of the rejection of claims 1, 2, 4, and 6-11 based on Gardner is respectfully requested.

Claims 3 and 5 Are Patentable Over Gardner and Wong

The Examiner rejected claims 3 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Gardner in view of U.S. Patent No. 5,890,175 to Wong [hereinafter "Wong"]. The Examiner contends that Gardner discloses all of the elements recited in the claims at issue except for providing an electronic shopping basket function, for which the Examiner cites Wong. The Examiner contends it would have been obvious to modify the method taught by Gardner to include the shopping basket functionality taught by Wong because "there is a demand for

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computer systems that can process increased transaction volume.” The Applicant respectfully disagrees with the Examiner’s characterization of these references vis-à-vis the claims at issue.

In support of this rejection, the Examiner cited FIG 15 and the following passages from Wong:

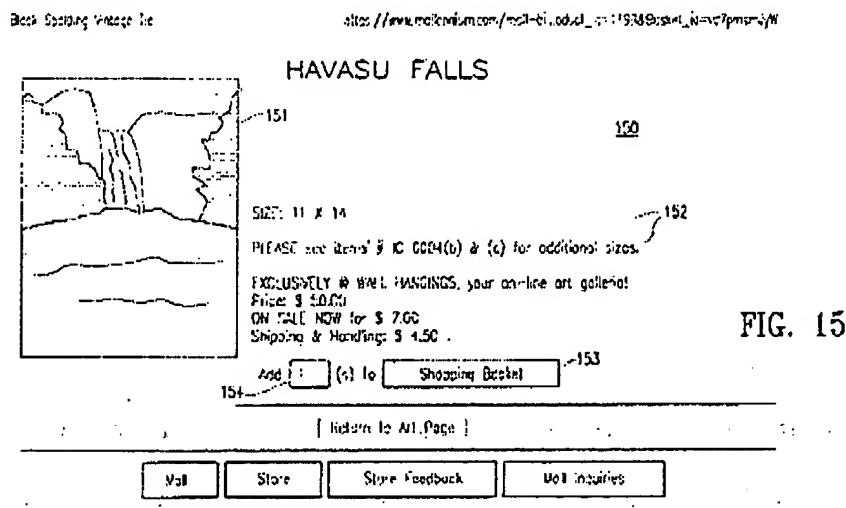


FIG. 15

Considering the expected growth in such transactions with the advent of the Internet, there will be a concomitant demand for computer systems that can process the increased volume of transactions. A major requirement for such systems will be the ability to adapt quickly to market demands.

Column 1, lines 20-25

Gardner fails to disclose the shopping basket functionality set forth in claims 3 and 5. However, Gardner teaches that a company-specific set of requisition rules should be used to authorize a purchase. As such, Gardner teaches away from a shopping basket function as disclosed by Wong.

Additionally, the basis provided by the Examiner for combining the teachings of Gardner and Wong lacks a relationship to the shopping basket functionality that the Examiner seeks to add to Gardner. The Examiner has shown no reason that a shopping basket function added to

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Gardner would provide increased transaction volume to the system of Gardner. In other words, there is no basis to conclude that the reason provided by the Examiner for combining the references would be achieved by such a combination. Consequently, one of ordinary skill in the art would not be motivated to combine the references for the reasons suggested by the Examiner. Therefore, the two teachings cannot be combined for the reason suggested by the Examiner to achieve the resulting combination.

For at least these reasons, Wong and Gardner cannot be combined in the manner suggested by the Examiner. Therefore, reconsideration and withdrawal of the rejection of claims 3 and 5 based on Gardner and Wong, either taken alone or in combination, is respectfully requested.

CONCLUSION

The Applicant respectfully submits this application is in condition for allowance and requests issuance of a Notice of Allowance.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to the deposit account of MICHAEL P FORTKORT PC, Deposit Account No. 50-3776.

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In the event the prosecution of this Application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

Respectfully submitted,

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